

Remarks

In the non-final Office Action mailed on 1 March 2007, the Examiner requested a new oath/declaration, rejected claim 7 under 35 U.S.C. §101 as directed to non-statutory subject matter, and rejected all claims (1-16) under 35 U.S.C. §102(b) as anticipated by Bianco (United States Patent Number 5,357,572).

Applicants have previously addressed the lack of Mr. Moss' signature on the oath/declaration. Further, Applicants respectfully traverse the Examiner's rejections, and request reconsideration and withdrawal of same. Applicants have amended various claims for editorial clarity and to better protect the invention and have cancelled claims 2, 8, and 14 with their respective recitations essentially integrated into respective base claims.

Oath and Declaration

The Examiner required a new oath/declaration noting the lack of signature by co-inventor Mr. Moss. Applicants have previously addressed the lack of Mr. Moss' signature with a timely filed, and now granted, petition to the Commissioner. A copy of the granting of that petition for an uncooperative inventor is attached hereto for review by the Examiner. Applicants respectfully request withdrawal of the Examiner's requirement for a new oath/declaration that includes the signature of Mr. Moss.

35 U.S.C. §101 Rejection

The Examiner rejected claim 7 under 35 U.S.C. §101 as directed to non-statutory subject matter suggesting that the claim recites a non-tangible result. The Examiner suggests that the recited method steps are not "tangibly embodied". Specifically the Examiner suggests modification to the preamble of claim 7 from: "A method operable within an integrated circuit to prevent unauthorized access to secure information" to now read: "A method operable within an integrated circuit stored in a flip-flops and registers to prevent unauthorized access to secure information".

First and foremost, Applicants respectfully disagree with the Examiner's mischaracterization of the method of claim 7 being directed to non-statutory subject matter. Claim 7 recites steps that comprise a method. A method is a process and a process is clearly enumerated in 35 U.S.C. §101 as patentable subject matter. Thus the Examiner is simply incorrect in suggesting that a method is not patentable subject matter. Secondly, assuming *arguendo* that the Examiner is correct in requesting the proposed change to the preamble of claim 7, the suggested change is simply incorrect. The method is not necessarily "stored" in flip-flops and registers" (typically would not be so embodied) but rather is more typically embodied in the integrated circuit as discrete and/or programmable circuitry of the integrated circuit - not strictly within flip-flops and registers of the integrated circuit as suggested by the Examiner.

However, in hopes of advancing prosecution of this application, Applicants have amended claim 7 to clarify that the claimed method is tangibly embodied within the integrated circuit. In view of the above discussion and the amendment to claim 7, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §101.

35 U.S.C. §102 Rejection

The Examiner rejected all claims (1-16) as anticipated by Bianco. In particular with reference to dependent claims 2, 8, and 14, the Examiner points to Bianco at column 4, lines 7-28 as teaching such a reset element (circuit, step, or means). Applicants strongly disagree with the Examiner's reading of such an element as taught or reasonably suggested at the cited portion of Bianco, or anywhere in Bianco, or anywhere in the prior art of record considered individually or in any combination. To the contrary, Bianco is silent as to any reset circuit, step, or means related to the security features.

In the subject application, the secure information is resident in programmable memory elements of the integrated circuit (e.g., flip-flops and registers) and thus the secure information is cleared by the reset circuit, step, or means. In other words, secure information loaded into the integrated circuit by operation thereof is erased (cleared or reset) by the reset circuit, step, or means. As recited in claims 2, 8, and 14, this reset is generated by logic within the integrated circuit simply in response to entry and/or exit

from a scan test mode. Thus the integrated circuit of the subject application may be fully tested in a standard scan test mode without risk of divulging secure information programmed therein.

Bianco addresses a similar problem of securing information from divulgence through scan testing. However, Bianco precludes access to the secure information by disabling (bypassing) scan test for any components within the circuit that contain secure information. Thus the components containing secure information are excluded from the scan test sequences in Bianco thereby limiting the testability of the circuit.

Claims 2, 8, and 14 depend from independent claims 1, 7, and 13, respectively. Claims 2, 8, and 14 have been cancelled with their respective recitations incorporated into claims 1, 7, and 13, respectively. Thus Applicants maintain that claims 1, 7, and 13 as amended are allowable over Bianco (and all art of record) for the reasons discussed above with respect to claims 2, 8, and 14. Claims 3, 5, 15, and 16 have been amended to depend from amended base claims. Applicants therefore maintain that remaining dependent claims 3-6, 9-12, and 15-16 are allowable for at least the same reasons as their respective, amended base claims 1, 7, and 13 and as dependent from allowable base claims. Applicants therefore respectfully request reconsideration and withdrawal of the rejection of remaining claims 1, 3-7, 9-13, and 15-16.

Conclusion

Applicants have previously addressed the Examiner's concern regarding lack of the signature on the oath/declaration for Mr. Moss. Applicants have traversed and thoroughly discussed the Examiner's §101 rejection of claim 7. Applicants have amended claims 1, 3, 5, 7, 13, 15, and 16 for editorial clarity and to better protect the invention and have cancelled claims 2, 8, and 14 with their respective limitations integrated into base claims 1, 7, and 13. Applicants have traversed the Examiners rejection of all claims under §102 and have requested reconsideration and withdrawal of all rejections.

No additional fees are believed due. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

Respectfully submitted,

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